

The '292 Application is a continuation of U.S. Patent Application No. 09/721,090, filed November 12, 2000 (hereafter "the '090 Application"). The '090 Application issued as U.S. Patent No. 6,310,606.

The '090 Application is a continuation of U.S. Patent Application No. 08/677,378, filed July 5, 1996 (hereafter "the '378 Application"). The '378 Application issued as U.S. Patent No. 6,222,525.

The '378 Application is a continuation-in-part of U.S. Patent Application No. 08/393,459, filed February 23, 1995 (hereafter "the '459 Application"). The '459 Application issued as U.S. Patent No. 5,565,891. As described in the Appeal Brief and previously filed Declaration, Figures 1-11 of the '459 Application provide support for the pending claims in the '025 Application.

The '025 Application claims priority to the '378 Application, but not the '459 Application. However, the claims of the '025 Application are supported by the '459 Application (and the subsequent parent applications), which was filed on February 23, 1995 – before the filing dates of the Autry and Hall references.

A declaration under 37 C.F.R. § 1.131 must include a showing of facts "to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." 37 C.F.R. § 1.131(b). Appellant has provided the required evidence. Specifically, Appellant has shown – thorough the inventor's Declaration – conception and constructive reduction to practice by the filing of the '459 Application.

Without citing any support, the Examiner's Answer states that it is "the examiner's understanding" that the filing date of the '459 Application can only be used for evidence of conception (Examiner's Answer at 23). The Examiner rejects Appellant's citation to the filing date of the '459 Application as evidence of a constructive reduction to practice. The Examiner misapplies the law on this point.

Specifically, there is no case law or rule that rejects or denies the use of a prior-filed patent application as evidence of reduction to practice – unless there was an intervening abandonment of the cited application. "[A]n abandoned application, with which no subsequent application was copending, cannot be considered a constructive reduction to practice. It is inoperative for any purpose, save as evidence of conception." *In re Costello*,

717 F.2d 1346, 1350 (Fed. Cir. 1983).

In the *Costello* case, the inventors had filed a first patent application, but then allowed it to go abandoned. The inventors then attempted to use the first, abandoned application as evidence of construction reduction to practice during the prosecution of a later-filed patent application. The present situation does include the key limitation in *Costello*. Specifically, there is no “broken chain” or abandonment between the originally filed ‘459 Application and the appealed ‘025 application.

Accordingly, the ‘459 Application demonstrates both conception and constructive reduction to practice of the claimed invention.

C. Conclusion

For the reasons discussed above and in the Appeal Brief, the rejections of claims 9-19 should be reversed.

Respectfully submitted,

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